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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Alan J. Fawcett

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06/13/2006

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

FERGUSON, MARISSA L

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

<b>Office Action Summary</b>	Application No. 10/500,947	Applicant(s) FAWCETT ET AL.	
	Examiner Marissa L. Ferguson-Samreth	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 27 March 2006.

2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-13 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-5 and 10-13 is/are rejected.

7) ☒ Claim(s) 6-9 is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All    b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>01-20-05 &amp; 10-31-05</u> .	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION *Claim Rejections* - 35 USC § 103**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,4,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fawcett et al. (US Patent 5,904,096) in view of Minnesota Mining and Manufacturing Company (GB Patent 1,533,431).

Regarding claims 1,2 and 4, Fawcett et al. teaches a plate steel back (14) to be secured to the machine and a metal impression layer (12) consisting of a photopolymer plate secured to the steel back and to engage a substrate (obvious since the method performed by the holding device is foil stamping) to impart an image thereto upon pressure being applied to the die plate and substrate by the machine. However he does not explicitly disclose a compressible adhesive layer that secures an impression layer to a steel back. Minnesota Mining and Manufacturing Company teaches a letter press with a compressible mounting material adhesive layer (layer 11 consists of mount 10 that is in combination with layers 20-22 and 24) that consists of an acrylic polymer (referring to polyacrylonitrile on Page 3, Line 33) and a phenolic based resin (Page 3, Lines 50-59) for securing a steel back.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention taught by Fawcett et al. to include

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the adhesive layer between the photopolymer plate and steel backing as taught by Minnesota Mining and Manufacturing Company, since Minnesota Mining and Manufacturing Company teaches that it is advantageous to have a compressible surface in order to compensate for adjustments between the plate surface and paper to thereby produce a sharp clean image without distortions.

Regarding claim 5, Fawcett et al. teaches an impression layer formed of brass, steel, copper, zinc, magnesium, aluminum or photo-polymer (12).

2. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fawcett et al. (US Patent 5,904,096) in view of Minnesota Mining and Manufacturing Company (GB Patent 1,553,431) as applied to claim 1 above, further in view of Procknow et al. (EP 0,235,677).

Regarding claim 3, Fawcett et al. and Minnesota Mining and Manufacturing Company both teach the claimed invention with the exception of an adhesive that is an epoxy resin. Procknow et al. teaches an interface epoxy material (Column 4, Lines 34-37) provided between a top steel back surface and base layer. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to further modify the invention taught by Fawcett et al. to replace the adhesive thereof with an epoxy resin adhesive as taught by Procknow et al., since Procknow et al. teaches that is advantageous to provide a strong bonding material for forming a more reliable plate surface.

3. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fawcett et al. (US Patent 5,904,096) in view of Minnesota Mining and Manufacturing

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Company (GB Patent 1,553,431) as applied to claim 1 above, further in view of Marbach (US Patent 4,256,026).

Fawcett et al. and Minnesota Mining and Manufacturing Company both teach the claimed invention with the exception of a die plate thickness of about 0.25mm to about 1 mm. Marbach teaches a stamping device with a die plate (2) with a thickness less than 1mm (Claims 2 and 7 on pages 4 and 5). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to further modify the invention taught by Fawcett et al. to replace the die plate thereof with a die plate with a thickness of 1mm and less as taught by Marbach, since Marbach teaches that is advantageous to provide a smaller thickness in order to maintain close contact thereby providing a clean sharper image.

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fawcett et al. (US Patent 5,904,096) in view of Minnesota Mining and Manufacturing Company (GB Patent 1,553,431) as applied to claim 1 above, and further in view of Wouch (EPO 0,235,677).

Fawcett et al. in view of Minnesota Mining and Manufacturing Company both teach the claimed invention with the exception of wherein a compressible adhesive only is disposed between the impression layer and the steel back. Adhesive is a commonly known method of bonding layers together. Wouch teaches using an adhesive only to secure a base layer to a steel plate (Column 4, Lines 34-36). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to further modify the invention taught by Fawcett et al. in view of Minnesota Mining and

Manufacturing Company to include an adhesive between the layers as taught by Wouch, since Wouch teaches that is advantageous to effectively secure layers thereby preventing slippage.

### ***Allowable Subject Matter***

5. Claims 6-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Regarding claim 6, the prior art does not teach or render obvious wherein a die plate has iron embedded in the adhesive.

### ***Response to Arguments***

6. Applicant's arguments filed 3/27/06 have been fully considered but they are not persuasive. With response to applicant's arguments on page 8, 4<sup>th</sup> paragraph, the examiner notes the adhesive layers stretch and are elastic (Minnesota Mining, page 4, lines 24-30). Therefore, the layers are compressible. The multiple layers 11, 12, 14 and 15 can reasonably be interpreted as a compressible adhesive. The claim does not require that the compressible adhesive comprise only one layer.

7. In response to applicant's argument on page 10 that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so

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found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, GB '431 teaches a printing plate wherein an impression element is inked and applied to a paper and Fawcett teaches a process of foil stamping. The applicant argues that both processes are technologically very different and unrelated, however, the examiner notes that both are methods that are used by applying some type of a force, whether the force be a greater force than the other. Both methods need to encounter a pressure in order to apply an impression as taught in GB '431 or to apply a thin metal to a surface in order to stamp a ornamental design as taught by Fawcett.

### ***Conclusion***

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa L. Ferguson whose telephone number is (571) 272-2163. The examiner can normally be reached on (M-T) 6:30am-4:00pm and every other (F) 7:30am-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marissa L Ferguson-Samreth  
Examiner  
Art Unit 2854

MFS

  
Daniel J. Colilla  
Primary Examiner  
Art Unit 2854